

Appl. No.: 10/720,029
Amdt. dated September 19, 2006
Reply to Office Action of June 21, 2006

Amendments to the Drawings:

Please replace Figure 1 with newly revised Figure 1.

Attachment: 1 Replacement Sheet

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REMARKS/ARGUMENTS

With this Amendment, Applicant amends claims 1, 19, 22 and 26 and adds claims 34-46. No new matter is added. Therefore, claims 1-46 are all the claims currently pending in the application. Based on the foregoing amendments and the following remarks, Applicant requests reconsideration and allowance of the claims.

I. Double Patenting

Claims 1-33 are rejected on the grounds of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-14 of Deeds (U.S. Patent No. 7,020,497; hereinafter "Deeds"). Applicant traverses this rejection for at least the following reasons.

Applicant respectfully submits that the Examiner has not properly applied the judicially created doctrine of obviousness-type double patenting. In particular, MPEP § 804 II.B.1., which guides the Examiner in such matters, requires that:

Any obviousness-type double patenting rejection should make clear:

- (A) The differences between the inventions defined by the conflicting claims – a claim in the patent compared to a claim in the application; and
- (B) The reasons why a person of ordinary skill in the art would conclude that the invention defined in the claim in issue is an obvious variation of the invention defined in the claim in the patent.

However, in support of the double patenting rejection, the Examiner provides no analysis regarding the differences between the inventions defined by the conflicting claims, and no analysis as to how the particular combinations of claims 1-33 are rendered obvious by claims 1-14 of Deeds. At least for these reasons, Applicant submits that the Examiner has not presented a *prima facie* case of obviousness-type double patenting.

Additionally, Applicant respectfully submits that the analysis which the Examiner does provide is incorrect. As correctly conceded by the Examiner, the conflicting claims are not identical, (See pg. 2 of the Office Action) however Applicant notes that claims 1-33 of the present application are patentably distinct over claims 1-14 of Deeds. In particular, nowhere in claims 1-14 of Deeds is there any teaching or suggestion, and the Examiner cites to none, relating, at least, to generating a ring-tune alert by applying the first ring tune enhancement to a

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base ring tune, as recited by independent claim 1 (and similarly recited by independent claims 19, 22 and 26). For at least the same reasons discussed above for independent claims 1, 19, 22 and 26, Applicant submits that dependent claims 2-18, 20-21, 23-25 and 27-33 are patentably distinct from claims 1-14 of Deeds. For at least the foregoing reasons, Applicant respectfully requests the Examiner to reconsider and withdraw the nonstatutory obviousness-type double patenting rejection of claims 1-33.

II. Objection to the Drawings

Figures 1 and 2 stand objected to because the Figures allegedly should be “designated by a label such as --Prior Art-- because only that which is old is illustrated.” (See pg. 3 of the Office Action)

Applicant has herein amended FIG. 1 to include a label such as Prior Art, as suggested by the Examiner. As such, Applicant submits that the amendment to FIG. 1 obviates the objection and Applicant respectfully requests the Examiner to reconsider and withdraw the objection to FIG. 1.

In objecting to Figures 1 and 2, the Examiner alleges that “there doesn’t appear to be anything unique about the figures shown with respect to the claims, other than these components, in general, just support the operation claimed.” (See *id.*) Applicant respectfully disagrees and points out that at least the third paragraph of pg. 11 of the specification describes that the mobile station 200 of FIG. 2 has components for providing enhanced ring tunes, as shown in FIG. 4 which are not old or well known in the art. As such, Applicant has not adopted the Examiner’s suggestion to amend FIG. 2 by adding a label such as “--Prior Art--” and Applicant respectfully requests the Examiner to reconsider and withdraw the objection to FIG. 2.

III. Rejection of Claims 1-33 Under 35 U.S.C. § 112, Second Paragraph

Claims 1-33 are rejected under 35 U.S.C. § 112, second paragraph as being allegedly indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. In rejecting claims 1-33, the Examiner alleges that “[t]he concept of the ‘enhanced ring tune’ ... has several meanings eg. it can be a change to the original

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tune” and the Examiner posits that the § 112, second paragraph rejection is put forth for the “express purpose of having the applicant more specifically define their ‘enhancing concept.’” (See pg. 4 of the Office Action) Applicant respectfully traverses this rejection for at least the following reasons.

Applicant notes that MPEP § 2173.04, which guides the Examiner in such matters, provides that “[b]readth of a claim is not to be equated with indefiniteness.” In regards to claims 1-33, a ring-tune enhancement is appended to a base ring tune to generate a ring-tune alert. While various types of ring-tune enhancements may be appended to a base ring tune, this breadth is by no means a sign of indefiniteness. In this regard, it is respectfully submitted that one skilled in the art will understand and appreciate the scope of the claims. For example, Applicant points out that at least the first paragraph of pg. 18 of the specification clearly describes an exemplary non-limiting embodiment of a ring tune that is applied to a base ring tune in order to generate an enhanced ring tune and that a skilled artisan clearly understands the scope of the claims in light of the specification. (See also second paragraph on pg. 15 of specification) Given that a skilled artisan clearly understands the scope of the claims in light of the specification and that the breadth of the claims does not render the claims indefinite, Applicant respectfully requests the Examiner to reconsider and withdraw the § 112, second paragraph rejection of claims 1-33.

IV. Rejection of Claims 1-8, 11-12, 17-19, 21-23, 26-29 & 31 Under 35 U.S.C. § 103(a)

Claims 1-8, 11-12, 17-19, 21-23 and 26-29 and 31 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Lin et al. (U.S. Patent No. 6,366,791; hereinafter “Lin”) and further in view of Speeney et al. (U.S. Patent No. 6,570,983; hereinafter “Speeney”).

Claim 1, as herein amended requires, “[a] method for providing a ring-tune alert in a communication device operable to receive communications via a communication network, . . .” comprising, *inter alia*, detecting an incoming communication, determining at least one communication characteristic of the incoming communication, associating a first ring-tune enhancement with the at least one communication characteristic, and generating a composite ring-tune alert *by appending the first* ring tune enhancement to a base ring tune.

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Applicant submits that the combination of Lin and Speeney does not teach or suggest at least the above features of amended claim 1. In contrast to claim 1, Lin relates generally to a telecommunications system for allowing network providers to download ringing tone patterns associated with one or more musical scores 55 to mobile stations 20 according to music selection of mobile subscribers to manipulate the ringing tone on the mobile station. More particularly, Lin, at best, discloses that ringing tone patterns, such as music, may be downloaded from HLR 26 or web page 45 to the mobile station 20 to distinctively identify different called party numbers (e.g., two phone numbers X & Y). A subscriber may select a specific ring pattern based on a first phone number and when an incoming call is received based on the ring pattern selected, the mobile station 20 may ring with the selected pattern (e.g., first music file). Similarly, the subscriber may select a different ring pattern based on a second phone number and when an incoming call is received based on the second phone number the mobile station 20 may ring with the selected pattern (e.g., second music file). (Col. 5, lines 1-50 of Lin)

In the Office Action, the Examiner correctly concedes that Lin does not teach or suggest “applying the first ring tune enhancement to a base ring tune.” (See pg. 5 of the Office Action) However, the Examiner relies on Speeney to make up for the deficient teachings of Lin. Particularly, the Examiner alleges that Speeney teaches “appending an audible announcement of the caller’s identity to the base ring tone.” (See *id.*) Applicant respectfully disagrees.

In contrast to claim 1, Speeney merely relates generally to a system for generating a communications identification announcement 304. Particularly, Speeney discloses that a communication (e.g., telephone call, e-mail) sent from a contacting party is transmitted to a subscriber and received by a communication device 160. A controller 210 recognizes an identifier 302 (e.g. telephone number, email address) of the communication of the contacting party. When the controller finds a match of the identifier in a database 170, an audio file may be retrieved and sent to terminal 150 which may play a corresponding communications identification announcement 304 (e.g., audio files and/or data files) which includes the identity of the author. (Col. 7, line 42 to Col. 8, line 48) For instance, if the identifier relates to an office telephone number 308, a voice announcement, “Mr. Smith wants you” 314 may be broadcast from the terminal 150. (See Col. 5, lines 24-30 & FIG. 3 of Speeney) Speeney discloses that

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“after a first ring of a telephone, and before the telephone is raised off-hook, a recorded voice may announce the name of the calling party.” (Col. 2, lines 33-36)

In view of the foregoing, Applicant submits that neither Lin nor Speeney alone or in combination teaches or suggests at least “generating a composite ring-tune alert by *appending the first* ring tune enhancement to *a base* ring tune,” as claimed. There simply is no teaching or suggestion, and the Examiner cites to none, that the combination teaches appending a data file (e.g., user’s recorded voice) to a ring tone, as suggested by the Examiner.¹ Instead, the combination, at best, discloses that a default ring tone 304 (i.e., “default announcement file”)² is first selected from database structure 300 when a calling party calls the receiving party and then a different and separate announcement 304 relating to the voice of the calling party is selected from database structure 300 so that the recorded voice is broadcast after the first ring and before a telephone is raised off-hook. (Col. 2, lines 33-36) As can be seen in FIG. 3 of Speeney, all of the announcements 304 in the announcement fields are distinct and separate and are not appended to each other. One skilled in the art understands that appended refers to use of a “ring tune that is conjoined or concatenated with the base ring tune,” as described in the second paragraph on pg. 15 of the specification. Contrary to the Examiner’s general allegation that Speeney teaches appending an announcement to a base ring tone, column 8, lines 36-46 of Speeney, at best, describes that when a party is called, an audio file (i.e., announcement 304) stored in database 300 is retrieved and is sent to the subscriber’s terminal 150 so that the audio file can be played by output device 250. Nowhere in the combination of Lin and Speeney is there any teaching or disclosure that the announcement 304 is appended to a base ring tone or a default ring tone of any type.

As discussed above, the combination of Lin and Speeney, at best, discloses that when a party is called, a default announcement file 304 (i.e., default ring tone) is retrieved from database 300 and is sent to subscriber terminal 150 so that a default ring tone can be broadcast via output device 250 and subsequently a controller 210 locates an announcement 304 in database 300 that matches a communication identifier 302 (e.g., telephone number) of the calling party. The matched announcement is then sent to the subscriber’s terminal 150 separately from the default

¹ See pgs. 3-4 of the Office Action pertaining to the Examiner’s § 112, second paragraph rejection.

² Col. 8, lines 9-11 of Speeney.

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ring tone so that the matched announcement is broadcast separately and distinct from the default ring tone via output device 250. Based on the foregoing, Applicant submits that the combination fails to teach or suggest generating a composite ring tune alert by appending the announcement (e.g., recorded voice) to a default ring (e.g. first ring of a telephone), as required by claim 1. Nowhere in the combination is there any teaching or suggestion that the announcement and the default ring tone, or any other ring tone, is a composite ring tune, as claimed.

For at least the foregoing reasons, Applicant submits that the combination of Lin and Speeney is deficient and does not teach or suggest all of the features of claim 1. Applicant therefore respectfully requests the Examiner to reconsider and withdraw the § 103(a) rejection of claim 1 and its dependent claims 2-18.

Since claims 19, 22 and 26 contain features that are analogous to, though not necessarily coextensive with, the features recited in claim 1, Applicant respectfully submits that claim 19 and its dependent claims 20-21 as well as claims 22 and 26 and their respective dependent claims 23-25 and 27-33 are patentable at least for reasons analogous to those submitted for claim 1.

V. Rejection of Claims 9, 20 & 30 Under 35 U.S.C. § 103(a)

Claims 9, 20 and 30 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Lin and Speeney and further in view of Schmidt et al. (U.S. Patent No. 6,363,258; hereinafter “Schmidt”). Applicant respectfully traverses this rejection for at least the following reasons.

As discussed above, the combination of Lin and Speeney is deficient vis-à-vis independent claims 1, 19 and 26, and Schmidt does not compensate for the deficiencies of the combination of Lin and Speeney. Applicant therefore respectfully requests the Examiner to reconsider and withdraw the § 103(a) rejection of dependent claims 9, 20 and 30.

VI. Rejection of Claims 10, 24 & 32 Under 35 U.S.C. § 103(a)

Claims 10, 24 and 32 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Lin and Speeney and further in view of Narinen et al. (U.S. Patent Appln. Publn. No. 2002/0115456; hereinafter “Narinen”). Applicant respectfully traverses this rejection for at least the following reasons.

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As discussed above, the combination of Lin and Speeney is deficient vis-à-vis independent claims 1, 22 and 26, and Narinen does not compensate for the deficiencies of the combination of Lin and Speeney. Applicant therefore respectfully requests the Examiner to reconsider and withdraw the § 103(a) rejection of dependent claims 10, 24 and 32.

VII. Rejection of Claim 13 Under 35 U.S.C. § 103(a)

Claim 13 is rejected under 35 USC 103(a) as being unpatentable over Lin and Speeney and further in view of Moss et al. (U.S. Patent Appln. Publn. No. 2002/0176554; hereinafter “Moss”). Applicant respectfully traverses this rejection for at least the following reasons.

As discussed above, the combination of Lin and Speeney is deficient vis-à-vis independent claim 1, and Moss does not compensate for the deficiencies of the combination of Lin and Speeney. Applicant therefore respectfully requests the Examiner to reconsider and withdraw the § 103(a) rejection of dependent claim 13.

VIII. New Claims

Applicant has added new claims 34-46 in order to more fully cover various aspects of Applicant’s invention as disclosed in the specification. In addition to their respective dependencies from claims 1, 19, 22 and 26, Applicant respectfully submits that claims 34-46 should be allowable because the cited combination of references do not teach or suggest the recitations of these claims.

IX. Conclusion

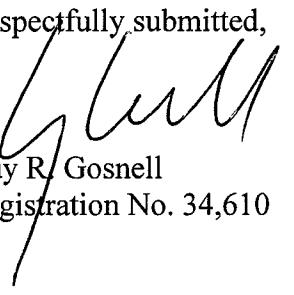
In view of the foregoing remarks, Applicant respectfully submits that all of the claims of the present application are in condition for allowance. It is respectfully requested that a Notice of Allowance be issued in due course. Examiner D’Agosta is encouraged to contact Applicant’s undersigned attorney to resolve any remaining issues in order to expedite examination of the present application.

It is not believed that extensions of time or fees for net addition of claims are required, beyond those that may otherwise be provided for in documents accompanying this paper.

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However, in the event that additional extensions of time are necessary to allow consideration of this paper, such extensions are hereby petitioned under 37 CFR § 1.136(a), and any fee required therefore (including fees for net addition of claims) is hereby authorized to be charged to Deposit Account No. 16-0605.

Respectfully submitted,



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